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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/062,552	04/20/1998	YOSHINOBU SHIRAIWA	35.G2135	3178

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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/062,552

Applicant(s)
Shiraiwa

Examiner
Mark Wallerson

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2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 10, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80-93 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 80-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 28 6) ☐ Other:

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **12/10/2002.**

2. This application has been reconsidered. Claims 80-93 are pending.

Allowable Subject Matter

3. The indicated allowability of claim 82 is withdrawn in view of the newly discovered reference(s) to Timmermans. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 80-87 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to claims 80, 86, and 87, there is no disclosure in the original specification for "wherein, when reproduction is not performed for the particular image,

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information relating to the particular image is stored in a memory” as disclosed in amended claims 80, 86, and 87. If Applicant believes this rejection to be in error, Applicant is requested to **SPECIFICALLY** provide support for this subject matter in the original specification.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 80, 81, 82, 83, 84, 85, 86, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (U. S. 6,111,659) in view of Timmermans (U. S. 5,862,297).

With respect to claims 80, 81, 86, and 87, Murata discloses an accessing unit (88) that accesses a recording medium (memory card), the recording medium having a plurality of reproducible images (image data files) and a reproduction instruction file (print job command file) containing plural file names specifying images to be reproduced (figure 6), the instruction file separate from the plural images (column 6, lines 40-46); means for reading the reproduction instruction file (column 8, lines 52-60); means for controlling reproduction of the images by reading the images specified by the reproduction instruction file (column 8, line 52 to column 9, line 1), and printing a reproducible image specified by the instruction file if the reproducible image is recorded in the recording medium (column 8, line 52 to column 9, line 1).

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Murata differs from claims 80, 86, and 87 in that he does not clearly disclose that reproduction is not performed for a particular image if that image is not recorded on the recording medium. However, it would be clearly obvious to one of ordinary skill in the art that if an image is not recorded on a recording medium (a disk), it cannot be read and printed.

Murata also differs from claims 80, 86, and 87 in that he does not clearly disclose that when reproduction is not performed for the particular image, information relating to the particular image is stored in a memory.

Timmermans discloses a photographic printing system wherein if picture parameter data stored on a disk is incorrect, a new set of picture parameter data is recorded on the disk (column 10, lines 36-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata so that when reproduction is not performed for the particular image, information relating to the particular image is stored in a memory. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata by the teaching of Timmermans in order to improve the image processing.

With regard to claims 83, 84, and 85, Murata discloses means for displaying the file name of the image to be reproduced and the image to be reproduced (column 7, line 60 to column 8, line 51).

With respect to claim 82, Timmermans discloses displaying information relating to the image not reproduced (column 10, lines 36-56).

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 88-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata in view of Haneda (U. S. 6,243,171).

With respect to claims 88, 90, 92 and 93, Murata discloses a recording control apparatus for controlling recording of images in a recording medium (memory card), the apparatus including an accessing unit (88) that accesses a recording medium for storing a plurality of reproducible images and a reproduction instruction file (column 6, lines 40-46) containing instruction information including plural file names (figure 6) specifying image data to be reproduced (print control data) (column 6, lines 40-46), comprising an indication section for indicating deletion of at least one of the images (column 3, lines 36-44), and a control section for controlling deletion of the instruction information in the instruction file corresponding to the indicated image (column 3, lines 36-44).

Murata differs from claims 88, 92, and 93 in that he does not clearly disclose that the accessing unit accesses the recording medium (accessed to specify an image to be reproduced) in accordance with a manual operation.

Haneda discloses a laboratory system wherein image data and order data recorded on a recording medium can be manually accessed by an operator in the laboratory (column 5, lines 30-

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39). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata wherein the accessing unit accesses the recording medium in accordance with a manual operation. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata by the teaching of Haneda in order to obtain more user control.

With regard to claim 89, Murata discloses the recording medium is a detachable memory (column 3, lines 45-50).

With respect to claim 91, Murata discloses a display unit to display the image to be deleted (figure 16).

Response to Arguments

10. Applicant's arguments with respect to claims 80-93 have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

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or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an
interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington. VA.

Sixth Floor (Receptionist)


MARK WALLERSON
PRIMARY EXAMINER

MARK WALLERSON